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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,285	03/04/2002	Frederic Greensaum	6311-055	6597
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PROSKAUER ROSE LLP PATENT DEPARTMENT 1585 BROADWAY NEW YORK, NY 10036-8299			EXAMINER MAGUIRE, LINDSAY M	
			ART UNIT	PAPER NUMBER
			3692	
			MAIL DATE	DELIVERY MODE
			03/27/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/090,285

Applicant(s)

GREENBAUM ET AL.

Examiner

LINDSAY M. MAGUIRE

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 37-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36, 51, and 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Final office action is in response to the application filed on March 4, 2002, the response to the Election/Restriction requirement filed on May 15, 2007, and the amendments filed on December 4, 2007.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-36, 51, and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. PG Pub. No. 2002/0059107 (Reich et al. '107).

Reich et al. '107 disclose a system for implementing a compliance program in a financial institution, comprising: a list data base (Figures 2-3; paragraph [0029]); a list manager, said list manager receiving a compliance query from an affiliate of the financial institution having a stats, said list manager providing a compliance response to said affiliate based on said plurality of entities and according to said status of said affiliate based on said plurality of entities and according to said status of said affiliate (paragraph [0026]). Additionally Reich et al. '107 disclose that wherein said material information regarding the plurality of entities is partitioned into a Grey list (36.2) and a Restricted list (36.1); wherein said affiliate is an employee (paragraph [0024], lines 5-7), said compliance query is requested by said employee to trade a security of an entity and said compliance response is a denial of said request to trade if said entity is included in the partition of said plurality of entities included in said Restricted list (paragraphs [0024-0034]); wherein said affiliate is a trader (paragraph [0024], lines 5-7; it is noted that the

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term "other party" is considered by the examiner to include 'a trader'), said compliance request is a request to trade a security of an entity and said compliance request includes at least one of said plurality of entities included in said Restricted list and a clearance code (paragraphs [0034-0035]); and wherein associated with said at least one of said plurality of entities is a transaction type and said request to trade has an activity type and wherein said clearance code denies said request to trade on said transaction type and said activity type (paragraph [0035]).

Furthermore, Reich et al. '107 disclose that said transaction type includes mergers and tender offers (paragraph [0034]); wherein said activity type includes derivative trading activity (paragraph [0037]); wherein said affiliate is a supervisory analyst (paragraph [0024], lines 5-7; it is noted that the term "other party" is considered by the examiner to include 'a supervisory analyst'), said compliance request is a request to issue a report regarding an entity and said compliance response includes at least one of said plurality of entities included in a combination of said Restricted list and said Grey list (paragraph [0057]); wherein said compliance response includes at least one safe harbor provision that grants at least a portion of said compliance request (paragraph [0044]); wherein said grant of said portion of said compliance request is based on geography (paragraph [0030]); wherein said affiliate is a compliance officer (paragraph [0024], lines 5-7; it is noted that the term "other party" is considered by the examiner to include 'a compliance officer'), said compliance request is a request to view at least a portion of a combination of said Restricted list and said Grey list and said compliance response includes said portion of the combination of said restricted list and said grey list (paragraphs [0033-0057]); wherein said compliance response includes for at least one of said plurality of entities included in said portion a clearance code and a transaction type (paragraph [0035]); and wherein said compliance response includes for at least one of said plurality of entities included in said portion a safe harbor provision (paragraph [0044]).

Reich et al. '107 also disclose a surveillance system wherein said surveillance system receives said plurality of entities stored in said list database for monitoring trading activity in accordance with said

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compliance program (paragraph [0048]); wherein said list database receives said plurality of entities from a compliance officer in communications with said system (paragraph [0024], lines 5-7; it is noted that the term "other party" is considered by the examiner to include 'a compliance officer'); wherein said list database receives at least a portion of said plurality of entities from a transaction information source (paragraph [0024]); wherein said list database receives positional information relating to said financial institution and wherein said compliance response is based on said positional information (paragraph [0030]); and wherein said list database receives affiliate directorship information and wherein said compliance response is based on said on said affiliate directorship information (paragraphs [0024-0036]).

It is noted that claims 19-36 are considered to be substantially similar to claims 1-18. Any argument to the contrary is considered to be an explicit argument for further restriction of the claims.

Regarding claim 51, Reich et al. '107 disclose a system for implementing a compliance program in a financial institution, comprising: a list database (Figures 2-3; paragraph [0029]) that stores material information regarding a plurality of entities that are known to the financial institution, the material information including a Grey List (36.2), a Restricted List (36.1), and restriction information related to the entities on the Grey List and the Restricted List (paragraph [0029]); and a list manager that receives a compliance query from an affiliate of the financial institution (paragraph [0026]), the list manager configured to respond to the compliance query by retrieving and displaying the information stored in the list database that is responsive to the compliance query (paragraph [0027, 0054, & 0060], Figure 5) .

In regards to claim 52, Reich et al. '107 disclose a method for implementing a compliance program in a financial institution, comprising: storing a plurality of entities in a list database (Figures 2-3; paragraph [0029]), the financial institution being associated with each of said plurality of entities; partitioning the entities stored in the list database into a Restricted List (36.1) and a Grey List (36.2); storing restriction information related to the entities on the Restricted List and the Grey List (paragraph [0029]); receiving a compliance query from an affiliate of the financial institution (paragraph [0026]); and

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responding to the compliance query with restriction information stored in the list database that is responsive to the compliance query (Figure 5, paragraphs [0027, 0054, & 0060]).

Response to Arguments

Applicant's arguments filed December 4, 2007 have been fully considered but they are not persuasive.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

However, Applicant's priority date is May 10, 2001, while Reich et al. '107's priority date is June 8, 2000, which is also a perfected priority date. Reich et al. '107 is available under both 35 USC 102 (e) and 35 USC 103 (a). Therefore, since Reich et al. '107 is still available prior art, and no argument has been presented as to the merits of the actual application of the reference to the claims, the rejection is maintained and made Final.

Applicant's argument's that Reich et al. '107 teaches a fully automated system, are acknowledged, however examiner is of another opinion. Specifically, Reich et al. '107 discloses that while the system is automated to a point, a TOC reviewer is appointed to review information on trades that the system deems to difficult to make a definitive "yes" or "no" decision about. Further, a user can request that a TOC review a proposed trade, and trades that are declined by the system can be vetoed after a TOC reviews the information (paragraphs 0027, 0054, & 0060], Figure 5). Therefore, Reich et al. '107 is considered to fully meet the limitations of the claims.

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Conclusion

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts of disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINDSAY M. MAGUIRE whose telephone number is (571)272-6039. The examiner can normally be reached on M-F: 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lindsay M Maguire/
Examiner, Art Unit 3692
3/14/08

/Kambiz Abdi/
Supervisory Patent Examiner, Art Unit 3692